

**REMARKS/ARGUMENTS**

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-30 are presently active; Claims 1, 12, 14, 24, 26, 27, and 30 have been amended.

In the outstanding Office Action, Claims 1, 6-8, 11, 14, 19-21, 26-28, and 30 were rejected under 35 U.S.C. § 102(e) as being anticipated by Tse (U.S. Pat. No. 6,198,845). Claims 2-3 and 15-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tse in view of Shirasawa (U.S. Pat. No. 5,689,590). Claims 4-5, 9-10, 17-18, 22-23, and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tse in view of Kamo (U.S. Pat. No. 5,465,160). Claims 12-13 and 24-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tse in view of Mortimore (U.S. Pat. No. 5,740,428).

M.P.E.P. § 2131 requires for anticipation that each and every feature of the claimed invention must be shown and requires that the identical invention must be shown in as complete detail as is contained in the claim. M.P.E.P. § 2143 requires for a *prima facie* case of obviousness that the prior art reference (or references when combined) must teach or suggest all the claim limitations.

In Claim 1 as clarified, one or more types of image processing is applied to image data so as to generate image processed data, and image processing identical to the one or more types of image processing is applied to a background level value so as to generate a threshold, followed by removing background noise from the image processed data according to the generated threshold.

The Office Action asserts that column 7, lines 49-65, and Fig. 10C of Tse disclose applying image processing identical to the one or more types of image processing to a background level value. Even if it were to be agreed, for the sake of argument, that the

Application No. 09/961,256  
Reply to Office Action of September 27, 2005

identical image processing is applied to a background level value, this asserted process does not generate a threshold that is subsequently used for background noise removal. The claimed invention defines that image processing identical to the one or more types of image processing be applied to a background level value so as to *generate* a threshold, and this *generated* threshold is then used for background noise removal.

The same argument applies to Claims 14 and 26 as clarified. Similar arguments also apply to Claims 27 and 30.

With respect to the invention of Claim 12 as clarified, it should be noted that Mortimore is directed to an image database. Claim 12 defines a choice between performing and non-performing of a background noise removal in a scanner. Applicant submits that the suggested combination of Mortimore and Tse fails to teach or suggest the provision of a choice between performing and non-performing of a background noise removal in a scanner.

Thus, for the above reasons, it is respectfully submitted that independent Claims 1, 12, 14, 24, 26, 27, and 30 and the claims dependent therefrom patentably define over the cited art of record.

Finally, it is respectfully requested *again* that the AA reference filed with the Information Disclosure Statement of March 4, 2002 be acknowledged by return of an initialed PTO 1449 Form. Attached herewith is the date-stamped filing receipt showing that all four references including the AA reference (U.S. Pat. No. 5,519,787) were submitted to the Patent and Trademark Office. Also attached is a courtesy copy of the filed IDS and the AA reference.

This amendment is submitted in accordance with 37 C.F.R. §1.116 which after final rejection permits entering of amendments canceling claims, complying with any requirement of form expressly set forth in a previous Office Action, presenting rejected claims in better form for consideration on appeal, or presenting amendments touching on the merits upon a showing of good and sufficient reasons why the amendment is necessary and was not presented

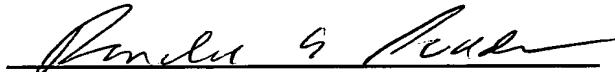
Application No. 09/961,256  
Reply to Office Action of September 27, 2005

earlier. The present amendment responds to the new grounds for rejection now asserted in the Office Action regarding the teachings of Tse.<sup>1</sup> Accordingly, Applicant would have had no reason to present the present amendments earlier. No new matter has been added. It is therefore respectfully requested that the present amendment be entered under 37 C.F.R. §1.116.

Consequently, in view of the present amendment and in light of the above discussions, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

  
\_\_\_\_\_  
Gregory J. Maier  
Attorney of Record  
Registration No. 25,599  
Ronald A. Rudder, Ph.D.  
Registration No. 45,618

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 08/03)  
GJM:RAR:clh

I:\ATTY\RAR\AMENDMENTS\214's\214247US\AM2.DOC

---

<sup>1</sup> Office Action., page 2, lines 17-19.